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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,557	06/29/2001	Andrew V. Anderson	42390.P9765X	6490

8791 7590 03/20/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030	**EXAMINER** CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2152	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Application No.	Applicant(s)
Office Action Summary		09/895,557	ANDERSON ET AL.
		Examiner	Art Unit
		Dohm Chankong	2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 February 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33 and 36-39* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33 and 36-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *1/10/2007*.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 7

DETAILED ACTION

1> This action is in response to Applicant's request for continued examination, filed,

2.6.2007. Claims 1, 11, 21, 27 and 31 are amended. Claims 1-33 and 36-39 are presented for further

examination.

2> This is a non-final rejection.

Response to Arguments

I. APPLICANT'S AMENDMENTS DO NOT PLACE THE APPLICATION IN CONDITION FOR
    ALLOWANCE.

Applicant's amendments do not place the application in condition for allowance.

Applicant's amendment is directed towards two new limitations: (1) wherein the intrusion to

the user is determined by rules specified by the user *and not by an administrator of the digital*

assistant and (2) the digital assistant responding to an originator of the event *to resolve the*

event in lieu of the user. The first limitation is not enabled by Applicant's specification.

Neither of the references overcome the Horvitz reference.

1. Applicant's first amendment is a negative limitation that is not supported by
    Applicant's specification.

The first limitation is a negative limitation as it serves to exclude an administrator

from specifying the rules utilized to determine whether to contact ("intrude") a user. Any

negative limitation or exclusionary proviso must have basis in the original disclosure. MPEP

§2173.05(i). The mere absence of a positive recitation is not basis for an exclusion. Id. Any

claim containing a negative limitation which does not have basis in the original disclosure

should be rejected as failing to comply with the written description requirement. Id.

Here, the limitation of excluding an administrator of the digital assistant from

specifying the rules of intrusion has no basis in the specification. Rather, Applicant's

specification states, with respect to rules, that "such information would be supplied by the

user and/or others to whom the user has given authority to add or edit rules, including but

not limited to, those who are setting up or maintaining automated assistant 100" [Applicant's

specification, 0015]. Thus, the specification contemplates allowing an administrator of the

digital assistant to add or edit rules.

Conceivably, an administrator may be excluded from doing so based on whomever a

user has given authority. However, functionality directed towards a user having the

capability of excluding an administrator from specifying the rules is not equivalent to

functionality stating that an administrator is excluded from specifying the rules. The

limitation should thus be focused on the user's ability to exclude persons such as an

administrator, and not on the specific exclusion of the administrator.

2.   Applicant's amendments do not overcome the prior art reference.

Furthermore, Applicant's amendments do not overcome the Horvitz prior art

reference. Applicant argues that Horvitz is merely directed at an auto-reply feature and is not

analogous to "resolving the event." However, Applicant's specification does not expressly

discuss "resolving an event." The closest language in Applicant's specification that relates to

"resolving an event" discusses taking appropriate action when the event is of enough

importance to require attention but not of enough importance to require contacting the user [Applicant's figure 2 | Applicant's specification, 0041].

In other words, since the specification is silent as to what actions constitute "resolving the event", the Office is free to give the limitation its broadest reasonable interpretation consistent with the specification. The Office interprets "resolving the event" as being analogous to "taking appropriate action." Looking to Applicant's specification, taking appropriate action by the digital assistant includes contacting another user (such as emergency personnel, secretary or family member) from an address book to contact in response to an event [Applicant's specification, 0027-0028].

Thus, in the Office's view, Horvitz's teaching of replying to the sender of the message is equivalent to resolving the event, where the event is the sender's email and "resolving" consists of notifying the sender that the user is not available and for how long the user will be unavailable.

With respect to the first limitation, Horvitz states that the user is responsible for specifying the rules as to when and how to be contacted [Figures 8-26]. This disclosure is analogous to Applicant's specification.

II.   Conclusion

For the reasons discussed above, the rejections set forth in the final rejection, filed 11.17.2006 are maintained. The Office suggests amending the language of the limitation to more clearly and precisely define the functionality of "resolving" the event. As the limitation is currently written, Horvitz still reads upon the limitation of "resolving the event."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3>   Claims 1-33 and 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a.   Independent claims are rejected for reciting the limitation excluding the administrator of the digital assistant from specifying rules concerning intrusion. This limitation is not supported by the specification.

b.   Dependent claims are rejected as a result of their dependency on the independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4>   The text of those sections of Title 35, U.S. Code not included in this action can be

found in prior Office actions, see 12.5.2005, 5.23.2006 & 11.17.2006. Only those claims that have

been amended are formally addressed in this action, see response above and rejections that

follow.

5>   Claims 1, 3-6, 10, 11, 13-16, 20-25, 27-29, 31-32, 36 and 38 are rejected under 35 U.S.C §

102(e) as being anticipated by Horvitz et al, U.S Patent Publication No. 2003|0046421

["Horvitz"].

6>   Regarding claims 1, 11, 21, 27, and 31-32, Horvitz discloses a method, a

computer readable medium comprising instruction and a digital assistant, e.g., computing

device ("system", hereinafter), comprising, steps, means and executable instructions for:

        providing a digital assistant having an event detector and an agent selector [Figure 3 |

0075, 0076];

        receiving by the event detector the information of an event from an information

provider [Figure 1 | Fig. 27 where : Horvitz's message controls receives information that a

message has arrived for user (event)];

        determining by the event detector the level of importance of the event relative to a

user of the digital assistant [0009, 0011, 0014-15, 0065, 0076, 0113 where : each arriving message

is given a priority (level of importance)];

weighing by the agent selector the level of importance against an amount of intrusion to the user if the digital assistant takes an action to resolve the event itself, wherein the intrusion to the user is determined by rules specified by the user and not by an administrator of the digital assistant [Figures 8-26 | 0108, 0275];

handling by the digital assistant the event without contacting the user if the level of importance of the event is greater than or equal to a first threshold and less than or equal to a second threshold, the handling including the digital assistant responding to an originator of the event to resolve the event in lieu of the user [Fig. 23-26 | 0017, 0074-75, 0083, 0108, 0275 where : user is not contacted if the message priority is not high enough to disturb the user (if he is in a critical, or more important, meeting). See also response above. The event (email from sender) is resolved (auto-reply with user's status to the sender) in the response to the sender]; and

contacting by the digital assistant the user in order for the user to resolve the event if the level of importance is greater than the second threshold [0075, 0076, 0103 where : if the message has a high enough priority, the assistant automatically forwards it to the user through his devices so he can immediately read ("resolve") the message].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7>   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8>   Claims 2, 12, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz, in view of what was well known in the art.

9>   Claims 7, 17, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz, in view of Fisher et al (US. 5,835,896).

10>   Claims 8-9, 18-19 and 33 are rejected under 35 U.S.C § 103(a) as being unpatentable over Horvitz.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Levinson, U.S Patent No. 6.047.260;

Shaffer et al, U.S Patent No. 6.094.681;

Levinson, U.S Patent No. 6.381.580;

Scheuring et al, U.S Patent No. 2002|0131565;

Strubbe et al, U.S Patent No. 6.604.059;

Alexander et al, U.S Patent No. 6.640.230;

Cooper et al, U.S Patent No. 6.757.362;

Alexander et al, U.S Patent No. 6.988.128.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER